



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
R.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,931	08/02/2000	Judith W. Zyskind	ELITRA.006A	9101

20995 7590 06/06/2003

KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
----------

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 06/06/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/630,931	ZYSKIND, JUDITH W.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Manjunath N. Rao, Ph.D.	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 07 April 2003.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-50 is/are pending in the application.

4a) Of the above claim(s) 1-6 and 21-50 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 7-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 August 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6, 9</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

Claims 1-50 are at issue and are present for examination. Claims 7-20 are now under consideration. Claims 1-6, 21-50 remain withdrawn from consideration as being drawn to non-elected invention.

***Election/Restrictions***

Applicant's election with traverse of Group II, Claims 7-20 in Paper No. 15 and *V.harveyi* as the species, is acknowledged. The traversal is on the ground(s) that coexamination of all of Groups II and IV would not be an undue burden on the Examiner. This is not found persuasive because while the searches for the two groups may overlap, they are not coextensive. As explained in the previous Office action, the above two groups are distinct inventions. While group II is directed to identification of any given polynucleotide sequence for having a promoter (directing or regulating transcription)activity, the invention of group IV is directed to quantify or compare the promoter activity of such identified polynucleotide sequences. Clearly the two groups are distinct inventions. Furthermore, as stated above while the searches for the two groups may overlap they are not coextensive. The search for Group IV would each require the search of subclasses unnecessary for the search of elected Group II and also involves extensive search of the non-patent literature.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-6 and 21-50 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 15.

***Priority***

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

***Drawings***

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 7-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Kalabat et al. (Biotechniques, 1998, Vol. 25:1030-1035). This rejection is based upon the public availability of a printed publication. Claims 7-20 of the instant application are drawn to a method of Identifying a given polynucleotide sequence for its promoter activity by linking it to a polynucleotide sequence encoding a chitobiase polypeptide or fusion protein comprising the chitobiase and a heterologous protein, wherein the encoded chitobiase lacks signal peptide sequence, wherein the polynucleotide encoding the chitobiase is obtained from V.harveyi and wherein the reporter gene construct is either introduced into the host cell either transiently or stably, wherein the host cells consists of prokaryotic or eukaryotic cells, wherein the method further comprises permeabilizing the host cells by treating with toluene and wherein the level of chitobiase activity is determined by measuring the amount of product released by the enzyme,

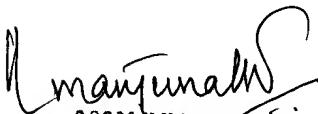
Art Unit: 1652

such as *p*-nitrophenol, wherein said test polynucleotide sequence comprises portion of genomic DNA and wherein the step of determining the level of chitobiase activity comprises determining the level after exposing the host cells to a desired set of environmental conditions and after contacting said host cells with a compound to be tested for its influence on the level of transcription from said regulatory element. Kalabat et al. disclose an identical method wherein a polynucleotide sequence is tested for its promoter activity by linking it to a polynucleotide sequence encoding a chitobiase polypeptide lacking a signal peptide sequence or fusion protein comprising said chitobiase and a heterologous protein, wherein the polynucleotide encoding the chitobiase is obtained from *V.harveyi* and wherein the reporter gene construct is either introduced into the host cell, *E.coli* either transiently or stably, and wherein the method further comprises permeabilizing the host cells by treating with toluene and wherein the level of chitobiase activity is determined by measuring the amount of product such as *p*-nitrophenol released by the enzyme, and wherein said test polynucleotide sequence comprises portion of genomic DNA and wherein the step for determining the level of chitobiase activity comprises determining the level after exposing the host cells to a desired set of environmental conditions comprising contacting said host cells with a compound such as IPTG to be tested for its influence on the level of transcription from said regulatory element. Therefore, Kalabat et al. anticipate claims 7-20 as written.

***Conclusion***

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

  
MANJUNATH RAO  
PATENT EXAMINER  
Manjunath N. Rao  
June 3, 2003